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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,579	12/20/2001	Frank F. Molock	VTN 571	1779
27777	7590	11/17/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			VARGOT, MATHIEU D	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,579	MOLOCK ET AL.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-23 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-30 and 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 25-30 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 24 has been amended to recite that the binding polymer is a particular copolymer of MMA and HEMA and it is unclear whether dependent claims 25-28 are now properly limiting or definite based on the amendment. For instance, it is not seen how the binding polymer can now be a silicone-based hydrogel as set forth in claim 25. Claim 26 should more properly be phrased as --wherein the copolymer further comprises lauryl methacrylate--. Claim 27 has already been recited in claim 24 and hence should be properly cancelled. Claim 28 would appear to be indefinite in that a HEMA homopolymer would not further limit the copolymer recited in claim 24.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-30 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakrar et al -040 generally for reasons of record noting the following.

Applicant has amended claim 24 to recite a particular copolymer with molecular weight and added new claims 42 and 43 reciting particular binding polymers. It is submitted that the amended claims are properly still rejected over the applied reference. Applicant uses a binding polymer which is HEMA or a copolymer of HEMA with PMMA and/or

other monomers, including an amide or ester as set forth in instant claim 42. The applied reference discloses (col. 3, lines 46-52) binding resins which would be selected from polymethylmethacrylate (PMMA), polyhydroxyethyl methacrylate and polydimethylacrylamide. Hence, the applied reference directly teaches PMMA. The instant HEMA is 2-hydroxyethyl methacrylate, which certainly would have been obvious from the disclosure of polyhydroxyethyl methacrylate in Thakrar et al -040. The acrylamide in the applied reference would render the amide comonomer recited in instant claim 42 as obvious. Hence, it is submitted that the instant claims are obvious over the applied reference, in that one of ordinary skill in the art would have been able to pick and choose suitable resins and molecular weights from the resins generally taught in Thakrar et al -040. The instant declaration is not probative and it is not clear exactly what applicant is attempting to show therein. Admittedly, Thakrar et al -040 does not disclose any molecular weights for the binding polymers. However, simply choosing HEMA (with a molecular weight much higher than the instant) as the binding polymer and showing that same (with the high MW) is not soluble in the solvents used in the applied reference certainly is not an indication that the instant claims are allowable over the reference. Thakrar et al -040 has chosen polymers which are soluble in the solvents used and one of ordinary skill in this art would have been directed to do the same. Also, it would not appear to be material as to whether the instant binding polymer swells in the solvent, but rather that the colorant dispersed in the binding polymer swells in the lens material when added thereto. Further, it is noted that only instant claim 43 uses HEMA with a molecular weight under 300,000. Hence,

even if the declaration were to be probative (which it is not, for reasons given), it could not be probative with respect to any claim other than 43.

3.Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the amendment, the 102 has been dropped in favor of a 103 rejection over the same reference. It is not clear exactly why applicant believes that the instant declaration renders the claims allowable over Thakrar et al –040. In essence, applicant is showing that the applied reference solvents are not suitable for HEMA polymer with a molecular weight outside the instant range. This might in fact have been expected—at any rate, it does not show any unexpected results, or results that would have rendered the instant claims allowable over Thakrar et al –040.

4.Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

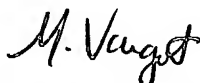
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
November 14, 2004


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

11/14/04